

REMARKS

This amendment is responsive to the Office Action of November 11, 2007. Applicants' representative thanks the Examiner for his time and courtesy during the teleconference on January 9, 2007, during which the finality of the subject Office Action was discussed and it was agreed that the finality of the Office Action dated November 11, 2007 will be withdrawn.

As discussed, at least one amendment to the claims was made in the reply to the Office Action dated June 7, 2007 that did not necessitate additional search by the Examiner. For instance, the subject matter of claim 10 was incorporated into independent claim 1, from which claim 10 originally depended. In the Office Action dated June 7, 2007, the Examiner rejected both claims 1 and 10 under §102(e) as being anticipated by a single reference (Chmaytelli). In the present Office Action, the Examiner has introduced a new grounds of rejection for independent claim 1, combining Lauterbach with Chmaytelli. However, MPEP 706.07(a), second paragraph, states in part:

“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in **37 CFR 1.97(c)** with the fee set forth in **37 CFR 1.17(p)**.” (Emphasis added.)

Since original claim 10 (which included all of the limitations of claim 1) was already searched by the examiner, and since the incorporation of claim 10 into claim 1 equates to the rewriting of claim 10 in independent form, the new ground of rejection introduced by the Examiner was *not* necessitated by applicants' amendment of the claims as required by MPEP 706.07(a). Accordingly, the finality of the Office Action dated November 16, 2007 is premature.

The Office Action

Claims 10 and 13 stand rejected under 35 U.S.C. §102(e) as being anticipated by Chmaytelli (PCT/US01/128491).

Claims 1-3, 5, 6, and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chmaytelli (PCT/US01/28491) in view of Lauterbach (U.S. Patent No. 5,278,539).

Claims 4 and 15-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chmaytelli (PCT/US01/28491) in view of Garudadri (U.S. Patent No. 6,519,479).

Claims 9 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chmaytelli (PCT/US01/28491) and Lauterbach (U.S. Patent No. 5,278,539) in view of Garudadri (U.S. Patent No. 6,519,479).

Rejection under 35 U.S.C. § 102(e)

Claims 10 and 13 stand rejected under 35 U.S.C. §102(e) as being anticipated by Chmaytelli. This rejection should be withdrawn for at least the following reason: Chmaytelli fails to disclose, either expressly or inherently, each and every limitation set forth in the subject claims.

BACKGROUND

The subject application relates generally to a communication device that permits a user to record a message and provide an address (e.g., a cell phone number, email address, etc.), and to pre-designate a transmission time (e.g., date and/or time) for the recorded message to be transmitted. Storage of the recorded message is in the mobile device (e.g., client-side) used to record the message rather than at a service provider server, which permits the message to be transmitted at the pre-designated time regardless of the service provider being used by the mobile device at transmission time. For example, "... the apparatus ... enables a user to enter a message well before a pre-designated day and/or time and to schedule it to reach a communication address at this day and/or time, independent of supplementary services offered by a communication network. Scheduling a birthday greeting is an

example of how a user could benefit from such an apparatus. When a user goes abroad, he will be able to send the birthday greeting as long as his telecom operator has a roaming agreement with a local telecom operator and his apparatus can use the local operator's communication network. It is not necessary for the local telecom operator to provide the same supplementary services as the user's own telecom operator." See e.g., page 2, lines 5-14. This explanation is only provided to facilitate a better understanding of the application and is not to be construed as limiting the claims in any way.

CLAIMS AND ANALYSIS

Independent claim 13 sets forth that "the communication software is stored on a record carrier." As stated in the reply to the Office Action dated June 7, 2007, Chmaytelli fails to disclose such aspects of independent claim 13.

The Examiner rejects the aspect of communication software being stored on a record carrier as being anticipated by paragraphs [1009]-[1011] of Chmaytelli, which describe recording a voicemail, and waiting until a "convenient" time to open a communication channel for delivering the voicemail. Moreover, "the *telephone* schedules 114 the voice mail message to be delivered at some later, convenient, time, and waits 116 until that time before opening 108 the communication channel." (Chmaytelli, paragraph [1009].) Chmaytelli is silent with regard to the manner in which the telephone selects a convenient time to open the communication channel.

However, claim 13 recites communication software comprising "a *function* for receiving a time entry specifying at least one of the elements of date and time, an address entry specifying a communication address, and a message entry; and a *function* for transmitting the message entry to the communication address depending on the time entry," which are stored on a record carrier. The cited paragraphs of Chmaytelli do not set forth such aspects.

With regard to the claims "record carrier," the Examiner contends that such aspects is anticipated by the memory 212 described in paragraph [1014] of Chmaytelli, which states, in its entirety:

"The processor 206 may include a timer 210 to initiate the sending of stored messages. *The messages are stored in a*

memory 212. When the convenient time comes, a transceiver 214 (if the telephone is a wireless telephone) opens a traffic channel to a desired telephone number and sends the message when an indication is received that the remote telephone (or other remote apparatus) at that number is ready. If the telephone is not wireless, then the transceiver 214 would be replaced with a line interface.”
(Emphasis added.)

The above mention of memory 212, which stores only messages (e.g., and not communication software, let alone communication software that performs the functions of claim 13), is the only mention of a memory or storage medium in the entire Chmaytelli reference. Chmaytelli states that the messages are stored in memory, but is silent with regard to any other information (e.g., date, time, communication address, etc.) being stored in the memory. Thus, Chmaytelli fails to describe the claimed aspects of independent claim 13.

In view of at least the foregoing, it is readily apparent that Chmaytelli fails to anticipate independent claim 13 (and claim 10, which depends there from). Accordingly, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 103(a)

Claims 1-3, 5, 6, and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chmaytelli (PCT/US01/28491) in view of Lauterbach (U.S. Patent No. 5,278,539). This rejection should be withdrawn for at least the following reason: The cited references, taken alone or in combination fail to teach or suggest every limitation set forth in the subject claims.

Independent claim 1 sets forth that a “control unit (9) comprises an auto-dialer (11) capable of initiating transmission of the message entry to the communication address when triggered and capable of attempting transmission to the communication address several times in order to successfully complete transmission of the message entry; and a timing device (13) is present, capable of triggering the auto-dialer (11) in dependence upon the time entry.”

The Examiner rejects the aspect of a timing device capable of triggering the auto dialer in dependence on the time entry as being anticipated by paragraph

[1013]-[1014] of Chmaytelli. Paragraph [1014] states that “*when the convenient time comes, a transceiver 214 opens a traffic channel to a desired telephone number and sends the message when an indication is received that the remote telephone...at that number is ready.*” Thus, the timer of Chmaytelli triggers the opening of a traffic channel, but not automatic dialing of a communication address, as claimed in independent claim 1. Rather, Chmaytelli does not transmit a message until and unless a readiness indication is received by the transceiver. Thus, Chmaytelli does not teach or suggest every element of independent claim 1.

Lauterbach fails to overcome the deficiencies of Chmaytelli with regard to the independent claim 1. Specifically, Lauterbach is silent with regard to a timer that triggers an auto-dialer to transmit a message. Accordingly, Chmaytelli and Lauterbach, alone or in combination, fail to make obvious independent claim 1 (and claims 2, 3, 5, 6, and 12, which depend therefrom). Withdrawal of this rejection is respectfully requested.

Claims 4 and 15-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chmaytelli (PCT/US01/28491) in view of Garudadri (U.S. Patent No. 6,519,479). This rejection should be withdrawn for at least the following reason: The cited references, taken alone or in combination fail to teach or suggest every limitation set forth in the subject claims.

Claim 4 has been amended herein to set forth the aspect of associating multiple transmission dates and times with a single message, which aspect was previously set forth in claim 17 (now cancelled). The examiner asserts that Chmaytelli discloses this aspect. However, Chmaytelli merely discusses opening a first channel to send a *first* message at a later convenient time (scheduled by the telephone) and opening a second channel at a later convenient time for sending a *second* message. Chmaytelli is silent with regard to associating multiple transmission times or dates with a single message. Moreover, Garudadri fails to overcome this deficiency of Chmaytelli.

Additionally, it is noted that the current rejection of claim 4 appears to be the same rejection previously presented regarding now-cancelled claims 7 and 8, aspects of which were incorporated into claim 4 by amendment in the reply to the Office Action dated June 7, 2007. As stated in that reply, independent claim 4 sets

forth a "control unit [that] includes an auto-dialer capable of initiating transmission of the message entry to the communication address when triggered; and a timing device that triggers the auto-dialer to transmit the message to the specified communication address at the at least one of date and time specified in the time entry; wherein the transmitter transmits a message entry with a prefix indicating that a message will follow, wherein the prefix comprises an electromagnetic signal received from a microphone."

The Examiner rejects the aspect of transmitting a message entry with a prefix indicating that a message will follow, wherein the prefix comprises an electromagnetic signal received from a microphone, as being obvious over the combination of Chmaytelli and Garudadri, citing the latter reference at Column 5, lines 35-52, and Column 6, lines 45-51. However, contrary to the Examiner's assertion, a careful review of the entire Garudadri reference yields no mention of a prefix appended to a recorded message, let alone a prefix that is entered via a microphone. Moreover, the prefix set forth in claim 4 permits a message recipient to distinguish between a real-time communication and a pre-recorded message. Rather, Garudadri relates to prompting a user to add a voice tag to a cell phone number or email address (e.g., to enter the phone number or email address into the user's voice-activated contact list) once the user has received a call or message from, or sent a call or message to, the phone number or email address a predefined number of times. This aspect of Garudadri does not anticipate using a microphone to add a prefix *to a voice message*.

Moreover, claim 4 clearly recites first and second memories with respective first and second interfaces, wherein a message entry is stored in the first memory via the first interface and date (and/or time) and communication address associated with the message entry is stored in the second memory via the second interface. The Examiner rejects this aspect of claim 4, citing the memory 212 of Chmaytelli. However, neither Chmaytelli nor Garudadri teaches or suggests storing date/time and address information separately from a message entry with which the date/time and address information is associated., let alone using separate and distinct interfaces to enter the message and the date/time and address information, respectively.

Accordingly, Chamytelli and Garudadri, alone or in combination, fail to make obvious independent claim 4 (and claims 15-20, which depend therefrom). Withdrawal of this rejection is respectfully requested.

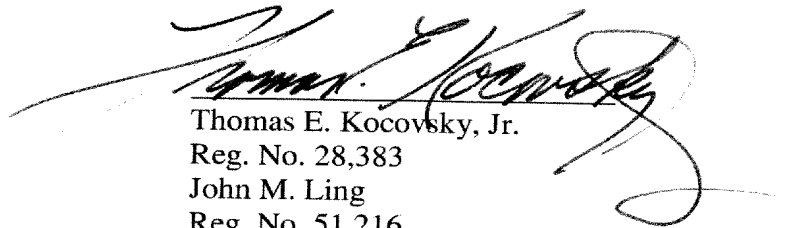
Claims 9 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chmaytelli (PCT/US01/28491) and Lauterbach (U.S. Patent No. 5,278,539) in view of Garudadri (U.S. Patent No. 6,519,479). This rejection should be withdrawn for at least the following reason: Claims 9 and 11 depend from independent claim 1, which, as discussed above, is not taught or suggested by the combination of Chmaytelli and Lauterbach. Garudadri fails to overcome the deficiencies of Chmaytelli and Lauterbach with regard to independent claim 1. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

For the reasons set forth above, it is submitted that claims 1-6, 9-13, 15, 16, and 18-20 meet the statutory requirements and distinguish patentably over the references of record. An early allowance of all claims is requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Thomas E. Kocovsky, Jr.", is written over the printed name and address.

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